

### **REMARKS**

Claims 1, 3-26, and 28-30 were previously pending. No claims have been added or canceled. Reconsideration of this application in light of the above amendments and the following remarks is requested.

While previously pending claim 28 was listed in the Office Action Summary as being rejected, no detailed rejection of claim 28 was provided. Further, the references cited in the Office Action, even if combined, do not teach the limitations of claim 28. Accordingly, Applicant has rewritten claim 28 in independent form and hereby requests an early indication of allowance for claim 28.

#### **§112 Rejections**

**Claims 9 and 10** stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. Claim 9 has been amended and as amended satisfies the requirements of 35 U.S.C. §112, second paragraph. Claim 10 depends from and further limits claim 9. Thus, Applicant respectfully requests that the §112 rejection of claims 9 and 10 be withdrawn.

**Claims 18-21** stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. In particular, the Office Action asserts that there is insufficient antecedent basis for the term “the insertion device” in claim 18. Applicant has amended claim 18 to replace the term “insertion device” with “medical instrument.” Similarly, claims 20 and 21 have been amended to replace “medical device” with “medical instrument.” As such, claims 18-21 satisfy the requirements of 35 U.S.C. §112, second paragraph and Applicant respectfully requests that the §112 rejection of these claims be withdrawn.

§102 Rejections

**Claims 1, 4, 6-9, 11-13, 15, 16, 22, 24-26, 29, and 30** stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,375,395 to Heintzeman (“Heintzeman”).

The PTO provides in MPEP §2131 that

“[t]o anticipate a claim, the reference must teach every element of the claim . . .”

Therefore, to sustain the rejections of claims 1, 4, 6-9, 11-13, 15, 16, 22, 24-26, 29, and 30 Heintzeman must teach all of the claimed elements of each claim.

With respect to amended independent claim 1, Heintzeman at least fails to teach, “a reflecting element spaced from the energy source and configured to reflect the energy path towards the indication surface.” While Applicant disagrees with the characterization of a laser energy source as equivalent to a reflecting element, claim 1 requires the reflecting element be spaced from the energy source. As such, Heintzeman clearly fails to teach such a reflecting element. For at least this reason Heintzeman fails to teach all of the elements of claim 1. Claims 4, 6-9, 11, and 12 depend from and further limit independent claim 1.

With respect to claim 6, Heintzeman also fails to teach, “wherein the attachment mechanism is adapted to direct the light towards a reflecting element.” Even following the Office Action’s interpretation that the laser energy source of Heintzeman includes a reflecting element, Heintzeman clearly does not include an attachment mechanism for directing light towards a reflecting element because the reflecting element is within the energy source from which the light is emitted. For at least this additional reason Heintzeman fails to teach all of the elements of claim 6. Therefore, Applicant respectfully requests that the §102 rejection of claims 1, 4, 6-9, 11, and 12 be withdrawn.

With respect to amended independent claim 13, Heintzeman at least fails to teach “a reflecting element spaced from the energy source for reflecting the energy path.” In that regard, Heintzeman fails to disclose having a reflecting element as recited. While Applicant disagrees with the characterization of a laser energy source as equivalent to the reflecting element recited in

claim 13 as asserted in the Office Action, claim 13 has been amended to require the reflecting element be spaced from the energy source. As such, Heintzeman clearly fails to teach such a reflecting element. Further, Heintzeman does not include “a surface for indicating the proximity of the reflected energy path to the energy source to indicate any alignment correction required for the instrument.” In that regard, Heintzeman fails to disclose having a reflected energy path and, therefore, necessarily fails to disclose a surface for indicating the proximity of the reflected energy path relative to the energy source. Thus, for at least these reasons Heintzeman fails to teach all of the claimed elements of claim 13. Claim 15 and 16 depend from and further limit independent claim 13. Therefore, Applicant respectfully requests that the §102 rejection of claims 13, 15, and 16 be withdrawn.

With respect to amended independent claim 22, Heintzeman at least fails to teach “a reflecting element spaced from the energy source and configured to reflect the energy path towards the surface.” As discussed above, while Applicant disagrees with the characterization of a laser energy source as equivalent to the reflecting element recited in claim 22 as asserted in the Office Action, claim 22 has been amended to require the reflecting element be spaced from the energy source. As such, Heintzeman clearly fails to teach such a reflecting element. For at least this reason Heintzeman fails to teach all of the elements of claim 22. Claims 24-26, 29, and 30 depend from and further limit claim 22.

### §103 Rejections

**Claims 10 and 17** stand rejected under 35 U.S.C. §103(a) as being obvious over Heintzeman in view of U.S. Patent No. 3,628,523 to Pirtle (“Pirtle”). However, claim 10 depends from and further limits independent claim 1 and claim 17 depends from and further limits independent claim 13. As shown above, Heintzeman fails to teach all of the claimed elements of claims 1 and 13. Pirtle does not affect this deficiency. Therefore, for at least the same reasons even when combined Heintzeman and Pirtle fail to teach all of the claimed elements of claims 10 and 17 and a prima facie case of obviousness cannot be established. Thus, Applicant respectfully requests that the §103 rejection of claims 10 and 17 be withdrawn.

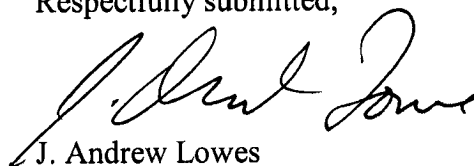
In an effort to expedite prosecution, Applicant will now address claim 23. While claim 23 was listed as rejected in the Office Action Summary, no detailed rejection of claim 23 was provided. However, similar to claims 10 and 17, claim 23 requires a needle. Thus, it is likely that the Examiner intended to reject claim 23 under §103 over Heintzeman and Pirtle in a similar manner as set forth for claims 10 and 17 above. However, claim 23 depends from and further limits claim 22. As shown above, Heintzeman fails to teach all of the claimed elements of claims 22. Again, Pirtle does not affect this deficiency. Therefore, for at least the same reasons even when combined Heintzeman and Pirtle fail to teach all of the claimed elements of claims 23 and a prima facie case of obviousness cannot be established.

**Claim 5** stands rejected under 35 U.S.C. §103(a) as being obvious over Heintzeman in view of U.S. Patent No. 6,428,180 to Karram et al. ("Karram"). However, claim 5 depends from and further limits claim 1. As shown above, Heintzeman fails to teach all of the claimed elements of claims 1. Again, Karram does not affect this deficiency. Therefore, for at least the same reasons even when combined Heintzeman and Karram fail to teach all of the claimed elements of claims 5 and a prima facie case of obviousness cannot be established.

**CONCLUSION**

Accordingly, it is clear that all of the pending claims 1, 4-26, and 28-30 are in condition for allowance. An early formal notice of allowance of the pending claims is requested.

Respectfully submitted,



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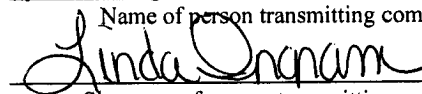
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